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EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/749,633

Applicant(s)

HITSON ET AL.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 6, 13, 14, 29 & 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 1, 13, 29 & 30, the phrases "or other device capable of stimulating human senses" and "or other device from which said content may be experienced" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or other device capable of stimulating human senses" and "or other device from which said content may be experienced"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
4. Regarding claims 1 & 29, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
5. Claim 6 recites the limitation "said device". In light of the rejection of Claim 1 based on the phrase "or other device from which said content may be experienced", there is insufficient antecedent basis for this limitation in the claim.
6. Regarding claim 14, the phrase "substantially contemporaneous" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed

(those encompassed by "substantially contemporaneous"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent US 6,628,302 B2 to White in view of US Patent US 6,317,795 B1 to Malkin.

9. Regarding Claims 1-3, 5, 8, 9, 12-14, 16, 19 and 25-30, White discloses a system and method for individualized custom content presentation through which users can influence presented content, comprising:

- a client PC or PMP capable of receiving data from and conveying data to a server, (Col. 2, lines 6-67);
- a server which conveys, receives and stores data, (Col. 2, lines 6-67), wherein said data is transmitted as a continuous stream, (per pending Claims 25 & 28), (Col. 7, lines 42-44 and Col. 8, lines 20 & 21), or as discreet files, (per pending Claims 27 & 28), (Col. 7, lines 42-62 and Col. 9, lines 29-31 – Examiner interprets discrete files to mean individual static files) or stored on removable media, (per pending Claims 26 & 28), (Col. 9, lines 4-21 – Examiner notes that the use of removable storage would

have been obvious in light of the servers ability to store data generally);  
and

- a server-based reporting tool;
- wherein said server stores content, content attributes and content reviews, (per pending Claim 2), (Col. 2, lines 17-31 and Col. 7, lines 1-62);
- wherein said server conveys some content information to a client along with said content, (per pending Claim 3), (Col. 2, lines 17-31 and Col. 7, lines 1-62);
- wherein users experience said content through a device, (Col. 2, lines 53-62);
- wherein users request information about or indicate a desire to purchase content before, during and after it is experienced, wherein said request is conveyed to a server, and wherein said request is used to select additional content for a client, (per pending Claim 9), (Col. 7, lines 1-62);
- wherein said content prepared with additional content information, is based on user, (or group), feedback and preferences, (per pending Claims 8 & 16), (Col. 7, lines 1-62; Col. 9, lines 43-67; and Col. 10, lines 1-2 – Examiner notes that any user grouping would have been obvious in light of the teachings of White), and compressed, (per pending Claim 19), (Col. 2, lines 37-40 and Col.

9, lines 4-21), and conveyed in a machine-readable format for the user to experience, (Col. 4, lines 12-58).

10. White does not specifically disclose a content rating system wherein users rate content and said ratings are used to generate usage statistics for content providers. Examiner notes, however, that as White discloses a feature by which the user may search a database, which database may include advertisement-related information, (Col. 4, lines 12-31), it would have been obvious for White to also include within the database, a statistical measure of user response to the same, for transmission to interested parties, (per pending Claim 12). Additionally, though White teaches compression techniques, White does not specifically note that the compression technique encompasses an encryption procedure. Further, White does not specifically teach event-based removal of content or server-approval-based experiencing of content.

11. Malkin discloses a method and system for dynamic modification of multimedia content that incorporates a rating system, (per pending Claims 5 & 14), (Abstract and Col. 4, lines 30-34), encryption techniques, (Fig. 10), and an expiration functionality, (Col. 4, lines 37-39), with time-based content specification, (Col. 20, lines 58-59). It would have been obvious to incorporate the Malkin functionalities into the White interactive video programming method as both Malkin and White are systems by which multimedia content is delivered to users over a computer network. Specifically, the added security functionalities of Malkin would be an obvious means by which the White

content could be controlled and regulated. Thus, Claims 1-3, 5, 8, 9, 12-14, 16, 19 and 25-30 are unpatentable over the combined teachings of White in view of Malkin.

12. Regarding Claim 4, White in view of Malkin is relied upon for those teachings disclosed herein. Malkin further discloses a custom content presentation system wherein a client (intermediate node) acts as a server, thereby providing content-related information stored thereon to other devices, (Fig. 2; Col. 5, lines 48-67; Col. 6; and Col. 7, lines 1-20). The motivation to combine White and Malkin is noted above. Thus, Claim 4 is unpatentable over the combined teachings of White in view of Malkin.

13. Regarding Claims 6, 10, 11 & 22, White in view of Malkin is relied upon for those teachings disclosed herein. White further discloses a user interface which allows a user to provide feedback concerning various content, enter preference information, or otherwise interact with content (on a server), (Col. 3, lines 40-45; Col. 4, lines 38-58; and Col. 7, lines 1-62), through appropriate means such as a wireless or wired communications medium, (per pending Claims 10 & 22), (Col. 10, lines 25-28), and to store information at the client for later transmittal to the server, (per pending Claim 11), (Col. 7, lines 24-35). The motivation to combine White and Malkin is noted above. Thus, Claims 6, 10, 11 & 22 are unpatentable over the combined teachings of White in view of Malkin.

14. Regarding Claim 7, White in view of Malkin is relied upon for those teachings disclosed herein. Malkin further discloses a custom content presentation system wherein data conveyed from said server contains proprietary or restricted content that is marked as such, and which said client may refuse to process if certain restrictions are

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not met, (Col. 6, lines 20-67 and Col. 7, lines 1-20). The motivation to combine White and Malkin is noted above. Thus, Claim 7 is unpatentable over the combined teachings of White in view of Malkin.

15. Regarding Claim 21, White in view of Malkin is relied upon for those teachings disclosed herein. White further discloses an interactive video programming method wherein content may be altered to match device capabilities or user specifications, (Col. 3, lines 18-20). Moreover, Malkin discloses a custom content presentation system with a content server which monitors content based on a client-specific content specification, (Col. 6, lines 20-67 and Col. 7, lines 1-20). The motivation to combine White and Malkin is noted above. Thus, Claim 21 is unpatentable over the combined teachings of White in view of Malkin.

16. Regarding Claims 15, 18, 20 & 24, White in view of Malkin is relied upon for those teachings disclosed herein. White further discloses an interactive video programming method wherein content preferences are entered by a user prior to content selection, and where such preferences are modified as content is experienced and user ratings, (per Malkin), are received, (per pending Claims 15, 20 & 24), (White - Col. 7, lines 1-62), wherein the user may refuse certain content types, (per pending Claims 18 & 24), (Malkin – Col. 7, lines 5-20). The motivation to combine White and Malkin is noted above. Thus, Claim 15, 18, 20 & 24 are unpatentable over the combined teachings of White in view of Malkin.

17. Regarding Claim 17 & 23, White in view of Malkin is relied upon for those teachings disclosed herein. Malkin further discloses a custom content presentation



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system wherein digital rights may be used to restrict content access, (Col. 7, lines 5-20).

Examiner interprets digital rights to mean the intellectual property right to possess and appreciate said content. Thus, Examiner finds that it would have been obvious generally, and in view of Malkin, to use digital rights as a means by which to restrict content access. The motivation to combine White and Malkin is noted above. Thus, Claims 17 & 23 are unpatentable over the combined teachings of White in view of Malkin.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 5,616,876 to Cluts.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak  
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Art Unit 2143

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